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S/N: 09/747,645

ELECTION

The Examiner identified two groupings of the claims: Group I containing claims 1-10 and Group II containing claims 11-26. Applicant elects, with traverse, what the Examiner has characterized as "Invention II", deemed drawn to a computer-readable medium having stored thereon one or more computer programs having a set of instructions executed by one or more computers, and corresponding to claims 11-26.

REMARKS

The Examiner has identified two "inventions" in the pending claims. The Examiner's classification of the "inventions" includes Group I consisting of claims 1-10 drawn to a method for measuring product shipment process capability and classified by the Examiner in class 705, subclass 28 and Group II consisting of claims 11-26 drawn to a computer-readable medium having stored thereon one or more computer programs having a set of instructions executed by one or more computers and classified by the Examiner in class 707, subclass 3.

The Examiner asserted that "Inventions I and II and related as subcombinations disclosed as usable together in a single combination." The Examiner asserted that "[i]n the instant case, invention II has separate utility such as query a database and repeating the query and creating upper and lower specification." Applicant disagrees and believes the "example" provided by the Examiner does not meet that which is required under MPEP §806.05(d).

Specifically, "[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." MPEP §806.05(d). However, the "example" provided by the Examiner appears to simply point out that independent claim 1 of Group I does not contain all of the same elements as independent claims 11 or 17 of Group II. This "example" does not meet the burden placed on the Examiner to provide an example under MPEP §806.05(d). That is, the Examiner's example cannot simply be to state that Inventions I and II are distinct because each and every element of the independent claims is not identical.

Applicant is entitled to claim the invention as Applicant sees fit. Variances in preambles or claim elements are not the standard for proper restriction. The Examiner must consider the

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claim sets as a whole in proffering a proper restriction. However, it appears that the Examiner has simply proffered the current restriction based on variances in the claim elements without considering the claim groups as a whole.

Specifically, claim 1, identified as Invention I, calls for "[a] method for measuring product shipment process capability" that includes "maintaining a database...fetching order information." On the other hand, claims 11 and 17, identified as Invention II, call for a computer or processor to "query a database" and "maintain a database," respectively. Claim 11 further calls for the computer to "repeat the query" while claim 17 calls for the processor to "create an upper specification limit" and "create a lower specification limit." The Examiner asserts that Invention II has separate utility because claim 1 does not include the elements of "repeat the query," "create an upper specification limit," and "create a lower specification limit." However, upon reviewing the claims identified as Invention I as a whole, it is clear that rejoinder is required. That is, claim 3 calls for "determining a value for an upper specification limit and a lower specification limit" and claim 5 calls for "the steps following maintaining the database are repeated." Therefore, the Examiner's assertion that "invention II has separate utility such query a database and repeating the query and creating upper and lower specification" is unsupportable because claims 3 and 5, identified as part of Invention I, expressly call for these very elements. Accordingly, the "example" proffered by the Examiner is expressly contradicted by the elements of claims 1-10. Therefore, under MPEP §706.05(d), Inventions I and II cannot be properly restricted and must be rejoined.

The Examiner also asserted that restriction is proper because "the search required for Group I is not required for Group II." However, as shown above, the scope of the groups as a whole are overlapping and, therefore, would necessitate an overlapping scope of search. Specifically, the Examiner asserted that a search required for Group I would not include a search for elements such as "repeat the query," "create an upper specification limit," and "create a lower specification limit," as required for a search of Group II. This is simply an unsupportable position. That is, claims 3 and 5, grouped by the Examiner in Group I, expressly call for "determining a value for an upper specification limit and a lower specification limit" and "the steps following maintaining the database are repeated." Therefore, a proper search of either Group I or Group II necessitates a search of these elements. Accordingly, Inventions I and II cannot be properly restricted and must be rejoined.

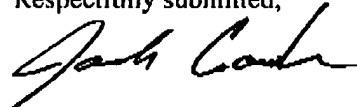
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Additionally, the Examiner classified claims 1-10 in class 705/28, which is entitled Data Processing for Inventory Management, and claims 11-26 in class 707/3, which is entitled Query Processing for Data Processing. The Examiner states that "the search required for Group I is not required for Group II...." However, reviewing of the claims, as a whole, the Examiner must consider "inventory management" when searching claims 11-26 since the claims specifically call for elements relating to inventory management as much as claims 1-10 do. For example, claim 11 calls for a database that contains information detailing orders, a requested delivery date, a max ship date, and a product category for a plurality of products, just to name one element. Conversely, claims 1-10 include query processes in a like manner to that called for in claims 11-26. For example, claim 1 calls for fetching order information for all orders that have a valid maximum ship date, which is just one example. Accordingly, the two exemplary classifications provided for the Examiner are relevant to both sets of claims, and the statement "the search required for Group I is not required for Group II" is simply not supportable.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



Jack M. Cook
Registration No. 56,098
Phone 262-376-5170 ext. 17
jmc@zpspatents.com

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P.O. ADDRESS:
Ziolkowski Patent Solutions Group, LLC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170